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Paper No. 13 RFC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re JH Thompson Enterprises, Inc.

Serial No. 75/470,627

Michael S. Culver of Oliff & Berridge, PLC for JH Thompson Enterprises, Inc.

Douglas M. Lee, Trademark Examining Attorney, Law Office 108 (David Shallant, Managing Attorney).

Before Cissel, Holtzman and Rogers, Administrative Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On April 20, 1998, applicant, a corporation of Pennsylvania located in Erie, Pennsylvania, filed the above-referenced application to register the mark "GREAT LAKES INSTITUTE OF TECHNOLOGY" on the Principal Register for "educational services, namely, conducting career training programs in the cosmetology, business and allied health fields," in Class 41. The application was based on applicant's assertion that it possessed a bona fide

intention to use the mark in commerce in connection with the specified services.

The Examining Attorney refused registration under Section 2(e)(2) of the Lanham Act on the ground that the mark applicant seeks to register is primarily geographically descriptive of applicant's services. In support of the refusal of registration, the Examining Attorney included a copy of an entry from Webster's New Geographical Dictionary for "Erie," the place where applicant is located, as "a city and port of entry" in the northwest corner of Pennsylvania, "on Lake Erie." The Examining Attorney concluded that the primary significance of the term "GREAT LAKES" is geographic, and that because applicant's services would emanate from the geographical place named in the mark, an association between the services and the place would be presumed. Also included with the refusal were copies of the results of a computerized search demonstrating the descriptive significance of the term "INSTITUTE OF TECHNOLOGY" in connection with educational services recited in the application.

Applicant responded to the Examining Attorney's first Office Action with both an amendment to allege use since September 7, 1998 and argument that the mark is not

geographically descriptive because "[a]pplicant does not provide its services in or on the Great Lakes. Concededly, Applicant is located <u>near</u> the Great Lakes, but proximity to a geographic location is not enough to support a refusal under Trademark Act Section 2(e)(2)..." Applicant cited In re Gale Hayman, Inc., 15 USPQ2d 1478 (TTAB 1990) for the proposition that applicant's location <u>near</u> one of the Great Lakes is insufficient to render its mark geographically descriptive.

The Examining Attorney accepted applicant's amendment to allege use, but was not persuaded by applicant's arguments as to the geographic descriptiveness of the mark, so the refusal to register under Section 2(e)(2) the Act was continued and made final. Submitted with the final refusal were copies of stories retrieved from the Nexis® database of published articles which use "Great Lakes" as the name of the region in which Erie, Pennsylvania is located. Also included with the final refusal were copies of five United States trademark registrations wherein the term "GREAT LAKES" is disclaimed. The Examining Attorney also pointed to the specimens of use submitted by applicant, which indicate that the term "GREAT LAKES" refers to a geographic region. The specimens state that "[i]n September 1998, in recognition of the regional

service area of the institution, it (applicant) became

Great Lakes Institute of Technology." The specimens go on

to note that applicant "offers career programs to the

residents of the Great Lakes area."

Applicant timely filed a Notice of Appeal, along with a request for reconsideration. Action on the appeal was suspended and the application was remanded to the Examining Attorney for reconsideration. He did not change his position, however. Included with his action on applicant's request for reconsideration were additional materials retrieved by the Examining Attorney from various websites which show use of the term "GREAT LAKES" as the name of the region in which applicant is located.

Both applicant and the Examining Attorney filed briefs. Attached as exhibits to applicant's brief were copies of third-party registrations argued by applicant to support its contention that the Office does not consistently require disclaimer of the term "GREAT LAKES," but the Examining Attorney properly objected to our consideration of this evidence because it was not timely submitted. The record closes with the filing of the Notice of Appeal. Trademark Rule 2.142(d) provides the procedure for making of record additional evidence that was not previously available, but applicant did not comply with

that rule. Moreover, it does not appear that the materials submitted with applicant's brief were unavailable before the filing of the appeal. The Examining Attorney's objection is sustained. We have not considered this evidence.

Applicant did not request an oral hearing before the Board.

Turning, then, to the merits of the issue raised by this appeal, we note that under Section 2(e)(2) of the Lanham Act, registration must be refused when the primary significance of the mark is that of a place generally known to the public, and the public would make an association between the goods or services specified in the application and the place named in the mark, i.e., they would believe that the goods or services set forth in the application originate in that place. See: In re California Pizza Kitchen, 10 USPO2d 1704 (TTAB 1989). See also: In re Carolina Apparel, 48 USPO2d 1542 (TTAB 1998); In re Handler Fenton Westerns, Inc., 214 USPQ 848 (TTAB 1982). The addition of a generic or highly descriptive term to a geographic term does not result in a mark which is not subject to refusal under Section 2(e)(2) of the Act. In re Cambridge Digital Systems, 1 USPQ2d 1659 (TTAB 1986); In re BankAmerica Corp., 231 USPQ 873 (TTAB 1986).

We hold that the refusal to register in the case at hand is appropriate because "GREAT LAKES INSTITUTE OF TECHNOLOGY" is a combination of a generic term, "INSTITUTE OF TECHNOLOGY," with a term whose primary significance is that of a geographic place, "GREAT LAKES." Because applicant's services do, in fact, emanate from the place named in applicant's mark, the association between the services and the place by customers of applicant's services can be presumed.

Applicant's principal argument is that its mark is not geographically descriptive because applicant's services do not come from the geographic place named in the mark, in that "applicant does not provide its services in or on the Great Lakes." (brief, p.2) Applicant contends that for this reason, the Examining Attorney has not established that consumers would make any association between the Great Lakes and applicant's services.

In the <u>Hayman</u> case, supra, cited by applicant in support of its position, the Board held that although that applicant's location (Century City) was close to the geographic location named in the mark (SUNSET BOULEVARD), a goods/place association had not been established. In the other case argued by applicant, Ex Parte Pacific Coast Aggregates, Inc., 91 USPQ 210 (Comm'r Pats. 1951), the

Commissioner held that while "PACIFIC" may not have primary significance as a geographical term, the combination "PACIFIC COAST" did, with respect to "any enterprise operating on the Pacific Coast." Applicant's position is that if its mark were "GREAT LAKES REGION INSTITUTE OF TECHNOLOGY," refusal under Section 2(e)(2) of the Act might be appropriate, but that because the word "REGION" is not part of applicant's mark, the refusal to register should be reversed.

We disagree. The record before us in this appeal establishes that applicant's mark combines a generic term for the services recited in the application with a term with primary geographic significance. The record shows that applicant is located in Erie, Pennsylvania, that Erie, Pennsylvania is part of the Great Lakes region, and that "INSTITUTE OF TECHNOLOGY" is a generic term in connection with the services set forth in the application. Simply put, the evidence amply demonstrates that the term "GREAT LAKES" is the name of a place, and even though that place is large enough to be termed a "region," the term nonetheless names the place, and it is that place where applicant's services are rendered. The fact that the mark sought to be registered does not include the term "REGION," is not fatal to the refusal to register under the Act.

Nor is the fact that applicant does not render its services in Lake Erie or on Lake Erie fatal to the refusal to register. As the geographical dictionary entry made of record by the Examining Attorney makes clear, it is common practice to refer to a location which is near a lake as being "on" the lake. (Erie was described as a city "on Lake Erie.") Also, as noted above, applicant's own materials promote the connotation of the term "GREAT LAKES" as referring to the region, rather than to the Lakes themselves. Applicant's explanation of its change of name from the "Private Academy for Career Training" to the "Great Lakes Institute of Technology" refers to "recognition of the regional service area of the institution" and offering career programs to the residents of "the Great Lakes area." As noted by the Examining Attorney, it is significant that applicant did not state that the new name was selected to refer to the five lakes themselves, but rather because the name refers to the area of land surrounding them.

The Examining Attorney distinguishes the two cases cited by applicant in support of the proposition that by selecting a mark which names a place which is only <u>near</u> where applicant renders its service, applicant may avoid the refusal of registration. Unlike the facts in Hayman,

in the case at hand, the applicant is located within the geographic place named in the mark, not merely near it. In the Pacific Coast case, although the Commissioner noted that the word "PACIFIC," by itself, is so broad that it might not be primarily geographically descriptive, the words "PACIFIC COAST" were held to be geographically descriptive in connection with a business which operated in that location. Just as the term "PACIFIC COAST" names a geographic location with some particularity, the record in the case at hand shows that "GREAT LAKES" identifies a specific location (which includes the place where applicant renders its services) with some degree of specificity.

In summary, when the mark here sought to be registered is considered in its entirety, its primary significance in connection with the services recited in this application is geographic. Accordingly, the refusal to register under Section 2(e)(2) of the Act is affirmed.